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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,250	12/22/2004	Gilbert Robert Bernard Germaine	TS5575US	9713

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EXAMINER
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BOYER, RANDY

ART UNIT	PAPER NUMBER
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1797

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03/17/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/519,250	<b>Applicant(s)</b> GERMAINE, GILBERT ROBERT BERNARD	
	<b>Examiner</b> RANDY BOYER	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Examiner acknowledges Applicant's response filed 20 December 2007 containing remarks.
2. Claims 1-4 are pending.
3. The previous rejections of claims 1-4 are maintained. The rejections follow.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benazzi (WO 01/81508 A1) in view of Biscardi (US 6579441).

7. With respect to claims 1 and 4, Benazzi discloses a process for the preparation of medicinal white oil from a paraffinic distillate bottom product (see Benazzi, Abstract; page 2, lines 21-22; and page 15, lines 28-29), wherein the paraffinic distillate bottom product is obtained by a process comprising: (a) hydrocracking/hydroisomerizing a liquid hydrocarbon feed (see Benazzi, page 6, lines 4-9), wherein the feed contains at least 20% boiling volume above 340°C (see Benazzi, page 3, lines 32-34; and page 4, line 1); (b) separating the product of step (a) into one or more distillate fractions of lower boiling fractions and a broad range base oil precursor fraction and a heavy fraction such that the T90 wt% boiling point of the base oil precursor fraction is between 350°C and 550°C (see Benazzi, page 8, lines 21-31); (c) performing a pour point reducing step to the broad range base oil precursor fraction obtained in step (b) (see Benazzi, page 10, lines 15-20; page 12, line 5; and page 13, lines 2-8); and (d) isolating a heavy bottom distillate fraction by distilling the product of step (c) (see Benazzi, page 14, lines 15-21).

Benazzi does not specify wherein the liquid hydrocarbon feedstock is “a Fischer-Tropsch derived paraffinic distillate bottom product,” wherein the weight ratio of compounds having at least 60 or more carbon atoms and compounds having at least 30 carbon atoms in the liquid hydrocarbon feedstock is at least 0.2 and wherein at least 30 wt% of compounds in the liquid hydrocarbon feed have at least 30 carbon atoms; or wherein the bottom product is contacted with a heterogeneous adsorbent.

However, Benazzi discloses that the liquid hydrocarbon feedstock is only limited to the extent that it contain at least 20% boiling volume above 340°C (see Benazzi, page 3, lines 32-34; and page 4, line 1). Otherwise, Benazzi provides an exhaustive, though non-exclusive, list of example feedstocks that includes vacuum distillates. Thus, Examiner finds Benazzi's disclosure to be sufficiently broad to encompass hydrocarbon feedstocks that are "Fischer-Tropsch derived paraffinic distillate bottom products," wherein the weight ratio of compounds having at least 60 or more carbon atoms and compounds having at least 30 carbon atoms in the liquid hydrocarbon feedstock is at least 0.2 and wherein at least 30 wt% of compounds in the liquid hydrocarbon feed have at least 30 carbon atoms. In addition, Biscardi discloses a process by which haze precursors are removed from base oils by contacting such oils with a heterogeneous adsorbent (see Biscardi, Abstract; column 3, lines 66-67; and column 4, lines 1-9). Biscardi explains that his process is most preferably used following a catalytic dewaxing process (e.g. step (c) of Benazzi) since haze precursors tend to be more abundant in oil that has been catalytically dewaxed (see Biscardi, column 5, lines 1-12). Specifically, Biscardi notes that a preferred base oil feed for contacting with the adsorbent generally boils above 260°C and has a viscosity, measured at 100°C, of at least 2.0 cSt (see Biscardi, column 5, lines 15-19) (e.g. the base oil obtained by the process of Benazzi, which boils at a temperature above 340°C and has a viscosity of at least 3.0 cSt at 100°C (see Benazzi, page 14, lines 15-29)).

Therefore, the person having ordinary skill in the art of processes for the preparation of medicinal and/or technical white oils would have been motivated to

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combine the process of Benazzi with the adsorption treatment process of Biscardi in order to remove any haze precursors remaining in the catalytically dewaxed base oil produced by Benazzi's process.

Finally, the person having ordinary skill in the art of processes for the preparation of medicinal and/or technical white oils would have had a reasonable expectation of success in combining the process of Benazzi with that of Biscardi because: (1) both Benazzi and Biscardi are directed to the production and/or upgrading of white oils; (2) Biscardi explicitly contemplates the use of his process in combination with an upstream catalytic dewaxing process (e.g. step (c) of the process of Benazzi); and (3) Biscardi discloses the use of a preferred base oil feedstock to be treated having the same characteristics as that of the base oil produced in the process of Benazzi.

8. With respect to claim 2, Biscardi discloses wherein the adsorbent comprises active carbon (see Biscardi, column 7, lines 50-59).

9. With respect to claim 3, Benazzi discloses wherein a medicinal white oil is obtained having a kinematic viscosity at 100°C of more than 3.0 cSt (see Benazzi, page 14, lines 26-29), a non-cyclic paraffins content of greater than 80 wt% (see Benazzi, page 15, lines 20-22), a Saybolt color of greater than +30 (see Benazzi, page 16, lines 19-21), UV adsorption spectra values of less than 0.60 in the 290-299 nm spectral band and less than 0.40 in the 300-329 nm spectral band (see Benazzi, page 16, lines 3-7).

***Response to Arguments***

10. Applicant's arguments filed 20 December 2007 have been fully considered but they are not persuasive.

11. Examiner understands Applicant's principal arguments to be:

- I. Biscardi is directed to removing haze and is not capable of meeting the Saybolt color specifications of the claimed process.
- II. One of ordinary skill in the art would not have combined Benazzi and Biscardi to produce a medicinal white oil.
- III. Biscardi teaches away from using adsorption for reducing color which is one of the key specifications in producing technical or medical white oils.

12. With respect to Applicant's first argument, Benazzi discloses a process of producing a medicinal white oil meeting the Saybolt color specifications of the claimed process. Thus, Applicant's argument is not persuasive because one cannot show nonobviousness by attacking references *individually* where the rejections are based on *combinations* of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

13. With respect to Applicant's second argument, see discussion *supra* at paragraph 7.

14. With respect to Applicant's third argument, Biscardi teaches adsorption for removing haze precursors from catalytically dewaxed oils such as the medicinal white oils produced by the process Benazzi (see discussion *supra* at paragraph 7). In this regard, Examiner again notes that one cannot show nonobviousness by attacking

references *individually* where the rejections are based on *combinations* of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy Boyer whose telephone number is (571) 272-7113. The examiner can normally be reached Monday through Friday from 8:00 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn A. Caldarola, can be reached at (571) 272-1444. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RPB

/Glenn A Caldarola/

Acting SPE of Art Unit 1797